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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,642	05/30/2001	Iliia Zverev	IFT774US	8001

24131 7590 09/26/2005  
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EXAMINER

JONES, HUGH M

ART UNIT PAPER NUMBER

2128

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/867,642

Applicant(s)

ZVEREV ET AL.

Examiner

Hugh Jones

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/1/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Introduction

1. Claims 1-5 of U.S. Application 09/867,642, filed 05/30/2001 are pending.

### Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

3. A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ishigami et al.

5. Ishigami et al. disclose that it was known in the art (as of at least June 26, 2000, the date of the incorporated foreign priority document) for a vendor to download to a customer a simulation program after an order is placed. See line 24, col. 1 to line 8, col.

2. See In re Epstein, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994).

6. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Beall et al..

7. Beall et al. disclose downloadable applets for simulation of circuit components which may be purchased from a vendor (See line 56, col. 15 to line 32, col. 16):

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"The information for a part might also be marked as having additional information associated with it on the World Wide Web. For example, the complete data sheet for a part, including all specifications, usage notes, and characteristics information, may be available as an HTML document, with its Universal Resource Locator ("URL") associated with the parts as one of its parameters. If an instance is selected and it has a URL associated with it, a "hot links" button 4075 will become active. The user may click on the hot links button 4075 to cause the browser 4014 to retrieve the HTML document, or download an applet in the form of executable content (for example, a circuit simulation applet to model the selected integrated circuit's performance). The user may choose to browse this associated information by choosing to view linked data, resulting in the launch of an instance of a Web browser with the URL. URLs may also be associated with any class, attribute, or standard attribute value within the knowledge base 4012. For example, a URL for an HTML document describing all of National Semiconductor's plastic integrated circuit package types could be associated with an enumerator for the attribute package type 4071. Selecting the option to view this linked data would launch the Web browser 4014 beginning at the URL, allowing the plastic package application notes to be viewed. Any of these associated URLs might also be Java applets, whose launch results in execution of the applet locally within the users Web browser 4014. For example, an output voltage attribute might have an associated HTML page containing an applet that interacts with the user, accepting various input parameters and dynamically graphing the resulting voltage or current curves representing device characteristics. This allows for interactive functionality associated with any database element to be delivered to the user on demand.

Finally, the user may decide to order a sample of a part. The user would choose an "order sample" link associated with the information displayed for a part, and an applet would run in the browser allowing the user to specify quantity desired, intended use, ordering and billing information. This information would be communicated using an executable content based

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remote procedure call mechanism to an application at National Semiconductor that would automatically verify and place the order for the user. An executable content based remote procedure call mechanism will be described in more detail below."

### **Response to Arguments**

8. The 112(1) rejections are withdrawn for reasons other than as provided by Applicants. Applicants have neither referred to their specification nor provided an affidavit in support of their allegations. However, a review of the applied prior art indicates that the claimed subject matter is such that those of ordinary skill in the art would be able to make and use the claimed invention.

9. Applicants argue (page 6, response of Feb. 1, 2005) that the novelty of the invention resides in the standalone nature of the simulator which can be downloaded and executes without the requirement that the computer be connected to the internet. Respectfully, this appears to be a step backward in the art. Simulation programs were standalone and accessed through ftp protocols, until recent advances in the internet allowed for the interactive features, such as running programs on the internet.

10. Applicants allege (page 8, of the response) that the "hearsay rule" is "clearly not applicable", but offer no explanation for the opinion. Applicants refer (page 8, response of Feb. 1, 2005) to the Ishigami disclosure as pointing to the Japanese priority document (2000-190811). In fact, the relevant date is June 26, 2000; the Examiner apologizes for the typo error. However, the fundamental rejection is not changed. Applicant's reference to "explicit words" is lacking and misleading. The statute recites:

“(a) the invention was known or used by others in this country, **or patented or described in a printed publication in this or a foreign country**, before the invention thereof by the applicant for a patent.”

*The document was described or patented in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.* Applicants have made no arguments on the merits of the rejection.

11. Applicant's allegations regarding Beall et al. are, respectfully, misleading and taken out of context. The Examiner agrees that Beall also discloses additional URLs (in the section cited by Applicants). However, Applicants are directed to lines 1-4 of col. 16, which immediately precedes the portion relied upon by Applicants. It states:

“The user may choose to browse this associated information by choosing to view linked data, resulting in the launch of an instance of a Web browser with the URL.”

Thus, the user has the option to browse additional information, but is not required to do so as alleged by Applicants.

12. The McDonald et al. rejection is withdrawn in view of Applicant's arguments.

### **Conclusion**

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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14. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be:

**directed to:**

Dr. Hugh Jones telephone number (571) 272-3781, Monday-Thursday 0830 to 0700 ET,

**or**

the examiner's supervisor, Jean Homere, telephone number (571) 272-3780.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

**mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051 (for formal communications intended for entry) **or**


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(703) 308-1396 (for informal or draft communications, please label  
*APROPOSED* or *ADRAFT*).

Dr. Hugh Jones

Primary Patent Examiner

April 20, 2005

  
HUGH JONES Ph.D.  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100